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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/092,895 | 03/08/2002 | Hiroshi Sukegawa | 220515US2S | 2724 |

22850 7590 05/04/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

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| EXAMINER |
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RHODE JR, ROBERT E

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/092,895 | Applicant(s) SUKEGAWA, HIROSHI | |
| | Examiner Rob Rhode | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 6-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/094895.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's election without traverse of claims 1 - 5 in the reply filed on 4-08-05 is acknowledged.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/092895, filed on 3-08-02.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 1 is objected to because of the following informalities: claim 1 stipulates comparing. It is recommended that the applicant use the word comprising rather than comparing, which could have been a translation change.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 5, the phrase "given frequency" is a relative phrase, which renders the claims indefinite. The phrase "given frequency " is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the phrase "given frequency" will be treated as a generic phrase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US 5,619,247) in view of Kobata (US 2002/0077985 A1).

Regarding claim 1, Russo teaches a music distribution method comparing:

Art Unit: 3625

requesting a server to distribute music information from a music reproduction apparatus through a communication medium; generating by said server a distribution file in which said music information requested and information concerning settings and conditions required for transmitting information from said music reproduction apparatus to said server are integrated; distributing by said server said distribution file to said music reproduction apparatus through said communication medium; and receiving by said server through said communication medium a number of times of reproduction of said music information reproduced by said music reproduction apparatus (see at least Abstract, Col 2, lines 66 -67, Col 3, lines 1 – 29).

While Russo does disclose setting and conditions for encryption, the reference does not specifically disclose a method of settings and conditions for transmission.

On the other hand, Kobata does teach a method of information concerning settings and conditions (Para 0156).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Russo with the method of Kobata to have enabled a method of information concerning settings and conditions. Russo discloses the claim language limitations and inventive concept of claim 1 (Abstract, Col 2, lines 66 -67, Col 3, lines 1 – 29). Kobata discloses a method of information concerning settings and conditions (Para 0156). Thereby, one of ordinary skill in the art would have been

Art Unit: 3625

motivated to extend Russo with the method of information concerning settings and conditions. In this manner, the conditions and settings will uniquely identify the user as well as providing the necessary information to send the audio/music content – without requiring any further information from the purchaser.

Regarding claim 2, Russo teaches a music distribution method, further comprising Requesting by said server to said music reproduction apparatus through said communication medium payment of a music-listening fee in accordance with said number of times of reproduction of said music information (Col 3, lines 1 – 29).

Regarding claim 3, Russo teaches a music distribution method according to claim 1, wherein said communication medium is the Internet (Col 6, line 33).

Regarding claim 4, Kobata teaches a music distribution method, wherein said information concerning said settings and conditions includes an Internet IP address required for reporting said number of times of reproduction of said music information from said music reproduction apparatus to said server (Para 0156).

Regarding claim 5, Russo teaches a music reproduction method, wherein said server receives said number of times of reproduction of said music information at a given frequency.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art includes Spagna (US 6,587,837 B1) and Ginter (US 5,892,900), which each discloses purchasing digital content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

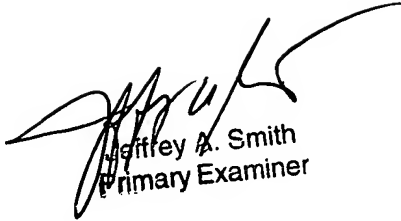
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Application/Control Number: 10/092,895

Page 7

Art Unit: 3625

Business Center (EBC) at 866-217-9197 (toll-free). RER



Jeffrey A. Smith
Primary Examiner